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09/630,157	07/31/2000	Christopher W. Gabrys		5434

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J. MICHAEL NEARY
542 SW 298TH STREET
FEDERAL WAY, WA 98023

EXAMINER	
KIM, CHONG HWA	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/630,157
Filing Date: July 31, 2000
Appellant(s): GABRYS ET AL.

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GROUP 3600

Michael Neary

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Feb 24, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on Oct 7, 2002 has not been entered. Furthermore, an affidavit attached to the amendment has not been entered. The appellant's Petition under Rule 181, dated Jan 2, 2003, for entry of the Amendment including the affidavit has been denied as recorded in Paper No. 14 and mailed on Jan 27, 2003.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-8 and 10-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,302,800 B1	Kundermann	10-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 and 10-20 are rejected under 35 U.S.C. 112, 1st Paragraph. This rejection is set forth in a prior Office Action, mailed on Jun 7, 2002.

Claims 7, 8, and 10-20 are rejected under 35 U.S.C. 112, 2nd Paragraph. This rejection is set forth in a prior Office Action, mailed on Jun 7, 2002.

Claims 7 and 8 are rejected under 35 U.S.C. 102(e). This rejection is set forth in a prior Office Action, mailed on Jun 7, 2002.

(11) Response to Argument

A. In response to the appellant's argument that the affidavit, with Exhibit A, illustrates that the open literature about the characteristics of materials can be applied with the teaching in the specification to make the invention, it is reminded that 35 USC 112, 1st paragraph states, "the specification shall contain a written description...**in such full, clear, concise, and exact terms as to enable any person skilled in the art**...to make and use the same..." (emphasis added). The affidavit with the Exhibit A (although it is not presented in the Appeals Brief) fails to show that **any person skilled in the art** would be enabled to make and use the invention. More specifically, the affidavit and the Exhibit A fail to show the material selection process for **any person skilled in the art** involved in making the elected invention as shown in Figs. 5 and 6. It appears that the growth rates for the rim liner and the rim are highly significant in the success of the invention. These growth rates depend on the material characteristics since the specification

describes that different ratios, that is the modulus elasticity over density, keep the rim liner and the rim remain in compressive contact. Therefore, it appears logical that selecting proper materials is also significant in making the invention. However, the specification fails to provide either specific properties of materials or the specific material selection process involved in making the invention. At best, the specification, as originally filed, contemplates the rim having materials such as glass and carbon fiber, wherein the inner winding 60 is made of E-glass and the outer winding 65 of carbon fiber. Simply describing the materials as E-glass and carbon fiber/epoxy would have any person skilled in the art guessing what exactly meant by such materials and create an undue burden on the person skilled in the art to research into exactly which composition of E-glass/carbon fiber/epoxy would be suffice to satisfy the claimed formula.

In order to overcome such insufficiency, the appellant provides the affidavit and the Exhibit A to show that any person skilled in the art would be enabled to make the invention by utilizing information provided in the *comparison Table 2* and in *PPG fiber glass product overview*. However, it is silent as to how exactly one obtained such information. Furthermore, simply providing specific material information beforehand, as in the case of the affidavit, to the manufacturer does not prove that any person skilled in the art would have made the same material selection, as provided in the Exhibit A, every time the invention is made. There are many different types of E-glass/epoxy or carbon fiber/epoxy compositions in the industry. No one in the industry would conclude that the E-glass meant the PPG fiber glass product; or the carbon fiber meant the EPON Resin 9405/EPI-CURE 9470 Curing Agent; or every E-glass would possess the same properties as the PPG fiber glass product; or every carbon fiber possess

the same properties as disclosed in Table 2. If the specific composition that satisfies the formula provided in the invention is available from the suppliers, then such suppliers should have been provided in the specification as originally filed. Without such information, it would create an undue burden on the person skilled in the art to carry out the invention.

Furthermore, 35 USC 112, 1st paragraph rejection also includes a discussion on the subject matter of "strain-to-failure capability" in which the appellant have failed to respond. Claims 7 and 14 recite such subject matter in which the specification fails to further describe in exact terms as to what it means by "strain-to-failure capability" and how one is to derive at the strain-to-failure capability of greater than 4%.

B. In response to the appellant's statement regarding the rejection under 35 USC 112, 2nd paragraph, it is noted that the proposed amendment in response to the rejection was not entered for raising new issues that would require further consideration and/or search; and the subsequent Petition filed Jan 2, 2003 to enter the amendment have been denied.

C. In response to the appellant's argument that Kundermann fails to mention the problem of differential radial growth due to centrifugal force and it is not a problem that would ever occur in an automobile, it is the Examiner's view that Kundermann does not need to mention the problem of radial growth. Kundermann shows, a flywheel system that experiences centrifugal force when rotating. It is inherent in every material that there exists properties such as modulus of elasticity and density. If such properties exist in a material, then one can draw a

conclusion that the material can "grow" as the centrifugal force is applied thereto. Nevertheless, claims 7 and 8 does not recite the language "grow".

In response to the appellant's argument that Kundermann fails to show a rim liner, it is the Examiner's interpretation that the element 23 of Kundermann is the rim liner in Fig. 13. It appears that the appellant has interpreted the Kundermann's reference from a different point of view than the Examiner's. It is noted that the claim has been given the broadest reasonable interpretation consistent with the specification. And accordingly, Kundermann shows, in Fig. 13, a hub for a flywheel system comprising the flywheel hub 33 having a radial splines 19 (since the claim or specification of the present invention does not specifically describe how or what the hub should look alike); a flywheel rim liner 23 with the radial projection 20 mating with the splines 19 (again, since the claim or specification of the present invention does not specifically describe how or what the rim liner should look alike); the rim liner 23 remaining in compressive contact with the rim 3 from start to maximum speed of the flywheel system (the rim 3 is the extended portion of the shaft 1 that receives the bolt 11 that maintains the compressive contact between the rim liner 23 and the rim 3); and as inherently shows, the rim liner 23 is made of a material having the strain-to-failure capability, the modulus elasticity, and the density.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

chk
July 27, 2004

CHONG H. KIM
PRIMARY EXAMINER

Conferees
David Bucci
Jack Lavinder

J. MICHAEL NEARY
542 SW 298TH STREET
FEDERAL WAY, WA 98023